

REMARKS

This Amendment, filed in reply to the Office Action dated January 4, 2006, is believed to be fully responsive to each point of rejection raised therein. Accordingly, favorable reconsideration on the merits is respectfully requested.

Claims 1-13 and 15-18 are all the claims pending in the application.

As a preliminary matter, the Examiner has indicated that copies of the priority documents have not been received. However, Applicant directs the Examiner's attention to Paper No. 6 (Office Action dated May 20, 2004) which indicates that the U.S. Patent Office has received the supporting priority documents.

Turning to the merits of the Office Action, claims 1-13 and 15-18 remain pending the application. Claims 6 and 11 have been rejected under 35 U.S.C. § 112, second paragraph, due to improper antecedent basis for certain claim recitations. A proposed correction is set forth above. Claims 11, 13, 6-9, 12 and 15, 10, 1-5, 16-18 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Tamura et al. (U.S.P. 6,771,896), Fujii et al. (U.S.P. 6,285,461) and Dawe (Article 9/29/98). Claim 15 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Tamura et al. , Fuji et al. and Dawe and further in view of Cone et al.(U.S. 2001/0054988) or Narayanaswamy et al.(U.S.P. 6,144,358). Applicant respectfully submits the following arguments in traversal of the prior art rejections.

Applicant's invention relates to methods and apparatus for providing confirmation of image data, such as via thumbnail of images, which are printed by a voucher printer separate

from an image printer. As an alternative method of confirmation, the technique of the present invention includes sending electronic mail, after an order has been placed, which includes thumbnail information and order information.

As an initial matter, the Examiner continues to contend that the feature of high precision image data being used to form the thumbnail should not be afforded patentable weight. Applicant submits that this feature should be accorded patentable weight for the reasons of record since none of the art of record specifies such high precision data for thumbnail formation.

Turning to the newly cited art, Fujii relates to preview of an image before an image is sent to a printer. Preview data is sent to a display so that a user can see the image to be printed. If an instruction to print the data is received (after the preview is displayed), the printing may continue. By contrast, if the instruction data indicates cancellation of the print data, then the preview process is terminated. Fujii, col. 12, lines 27-40 and Fig. 4. No print is ordered in this circumstance.

Dawe relates to a method of creating confirmation correspondence and invoices for the ordering of DELL computer products.

The Examiner maintains that the combination of Tamura, Fujii and Dawe teaches each feature of claim 1. The Examiner concedes that the Tamura and Fujii together do not teach a separate printer for the thumbnail image print out. See Page 7, Detailed Action, First Full Paragraph. The Examiner cites Dawe to teach this feature. Applicant submits that the rejection is not supported for at least the following reasons.

As an initial matter, Dawe is drawn from non-analogous art. The article relates to how to bill for computer sales. This has nothing to do with the print ordering system as claimed, and none of the problems in computer sales invoicing would be applicable to the formation of thumbnail outputs and image ordering. Therefore, claim 1 is patentable for at least this reason.

Further, claim 1 describes a separate printer for the image printer and the voucher printer which outputs the thumbnail. The Examiner concedes that Tamura and Fujii do not teach this feature, as set forth above. The Examiner contends that it would be obvious to include a separate voucher for mailing to the customer. However, even assuming *arguendo* that Dawe may be combined with Tamura and Fujii, there is no requirement that Dawe must print the voucher using a printer separate from an image printer. To the extent Tamura allows confirmation information to be printed, the confirmation and image can be output via a common printer and still allow the orderer to obtain the confirmation information as suggested by Dawe. In other words, there is no separate requirement for an image printer and voucher printer.

Therefore, claim 1 is patentable for at least these reasons. Because claim 10 includes features analogous, though not necessarily coextensive with claim 1, claim 10 is patentable for the reasons set forth above for claim 1.

With regard to claim 11, this method describes transmitting the voucher via electronic mail after an order has been placed, and the image data corresponds to that transferred to the image printer. The Examiner cites various aspects of Tamura and Fujii as suggesting this feature. With regard to Tamura, the Examiner cites to col. 12, lines 33-49. However, this cited

portion does not relate to print previewing or thumbnail formation but merely describes an approximate time for processing completion. The Examiner's citations to Fujii relate to previewing of data prior to making a print. However, claim 11 describes transmission of the print order data after an order. Further, in the pending claims, the thumbnail is based on image data sent to the image printer. Because the previewing of Fujii occurs prior to a print order, this cannot meet the features of claim 11. Therefore, claim 11 is patentable for at least these reasons.

Because claim 6 includes features analogous, though not necessarily coextensive with claim 11, claim 6 is patentable for the reasons set forth above for claim 11.

The remaining claims are patentable based on their dependency. The additional references of Cone and Narayanaswamy do not make up for the deficiencies of the primary combination.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

AMENDMENT UNDER 37 C.F.R. § 1.111
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The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.


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